

REMARKS

Claims 1, 3-10 and 12-22 are pending. Claims 2 and 11 have been canceled without prejudice.

Claims 1, 7, 10, 16 and 19 to recite that the catalyst in each of the two laminated electrode layers of the negative electrode consists essentially of fine particles of platinum or an alloy thereof. Support for this amendment can be found in the last full paragraph of page 8 of the specification.

No new matter has been added by way of the above-amendment.

I. Issues under 35 U.S.C. § 103

The following rejections are pending:

- (A) Claims 1, 3, 4, 6-10, 12, 13 and 15-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Tabata et al.** (US 2002/0071980) in view of **Ueda et al.** (US 2004/0115515), and further in view of **Kohler et al.** (US 2003/0224223); and
- (B) Claims 5 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Tabata et al.** in view of **Ueda et al.** and **Kohler et al.** as applied to claims 1 and 10 above, and further in view of **Dube et al.** (US 2004/0089357).

Applicants respectfully traverse Rejection (A) and Rejection (B).

In order to further clarify the distinction between the present invention and the cited prior art, Applicants have amended 1, 7, 10, 16 and 19 to recite that the catalyst in each of the two laminated electrode layers of the negative electrode consists essentially of fine particles of platinum or an alloy thereof.

It is noted from the last full paragraph on page 3 of the outstanding Office Action that the Examiner is relying on the Ueda et al. reference for disclosing "a bilayer structure catalyst layer wherein each catalyst layer has a thickness that is usually 2 to 50 μm which corresponds to a total

thickness of the laminate that is 4 to 100 μm ..."

However, paragraph [0072] of Ueda et al mentions that the catalyst layer having a bilayer structure is characterized in that the catalyst layer includes gold fine particles formed on a platinum catalyst layer. Thus, even if Tabata et al. and Ueda et al. are combined, it is not possible to arrive at a configuration in which the catalyst in each of the electrode layers consists essentially of fine particles of platinum or an alloy thereof as recited in the present invention.

Consequently, the invention described in independent claims 1, 7, 10, 16 and 19 is not made obvious by Tabata et al., Ueda et al. and Kohler et al, since the combination of Tabata et al., Ueda et al. and Kohler et al, does not teach or fairly suggest the inventive negative electrode which comprises a laminate of at least two electrode layers each containing a catalyst consisting essentially of fine particles of platinum or an alloy thereof. Accordingly, withdrawal of Rejection A is respectfully requested.

With respect to Rejection B, the Examiner cites Dube et al. for teaching an adhesive layer having a specific thickness. Applicants respectfully submit that claims 5 and 14 are allowable for the reasons set forth above for independent claims 1 and 10, respectively. Nevertheless, Dube et al fail to mention an adhesive layer associated with a fuel cell. Accordingly, the skilled artisan would not look to the teachings of Dube et al. relating to integrated electrofluidic systems to modify the fuel cells of Tabata et al. The mere fact it is possible for isolated disclosures to be combined does not render the result of that combination obvious absent a logical reason of record which justifies the combination. *In re Regel et al.* (CCPA 1975) 526 F2d 1399, 188 USPQ 136. To properly combine references to reach a conclusion of obviousness, there must be some teaching, suggestion of inference in either or both of the references, or knowledge generally available to one of ordinary skill in the art, *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Interfer. 1993), which would have led one to combine the relevant teachings of the two references. *Ashland Oil Inc. v. Delta Resins and Refractories, Inc. et al.* (CAFC 1985) 776 F2d 281, 227 USPQ 657. Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art, not in Applicant's disclosure. *In re Vaeck* (CAFC 1991) 947 F2d 488, 20 PQ2d 1438. The

combination is improper if one of the references is non-analogous art. *In re Clay* (CAFC 1992), 23 PQ2d 1058. Therefore, Rejection B is untenable and withdrawal thereof is respectfully requested.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Conclusion

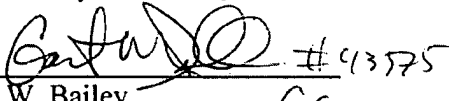
In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq., Reg. No. 43,575 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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